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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/579,028

05/11/2006

Emily Jane Canada

X16554

8539

25885 7590 11/19/2009
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PATENT DIVISION
P.O. BOX 6288
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EXAMINER

DAVIS, ZINNA NORTINGTON

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

11/19/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@lilly.com

Office Action Summary	Application No. 10/579,028	Applicant(s) CANADA ET AL.	
	Examiner Zinna Northington Davis	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 5-7, 9, 11, 12, 16, 20-22, 24-27, and 39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 27 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9, 11, 12, 16, 20-22, 24-26 and 39 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

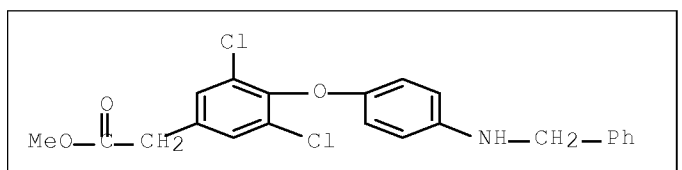
1. Claims 1, 5-7, 9, 11, 12, 16, 20-22, 24-27, and 39 are pending.
2. Claims 2-4, 8, 10, 13-15, 17-19, 23, 28-38, and 40-45 have been cancelled.
3. Based upon the response filed July 22, 2009, the rejections based upon 35 U.S.C. 112, 2nd paragraph and 35 U.S.C. 102(b) based upon Link et al. are withdrawn.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1 and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kao Bio Ab [WO 02/062780, (Reference N, cited by the Examiner)].

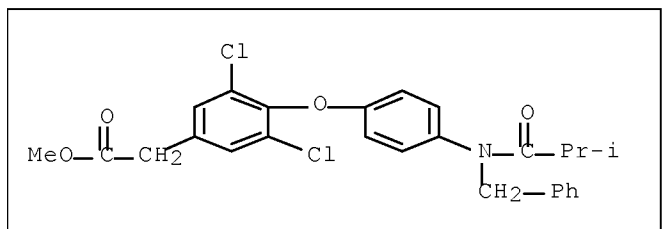
The instantly claimed compounds are disclosed. At page 23, line 30, see the named compound. The compound is depicted below:



The claims are fully met when A is phenyl; R^1 and R^8 are hydrogen; R^2 is halogen; D_a is a direct bond; X is NR^7 ; R^7 is hydrogen; D_b is CH_2 ; Y is bond; R^3 and R^4 are hydrogen; Q is $-\text{C}(\text{O})\text{OR}^5$; and R^5 is methyl.

At page 24, line 5, see the named compound. The compound is depicted below:

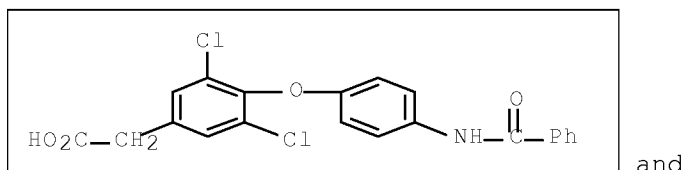
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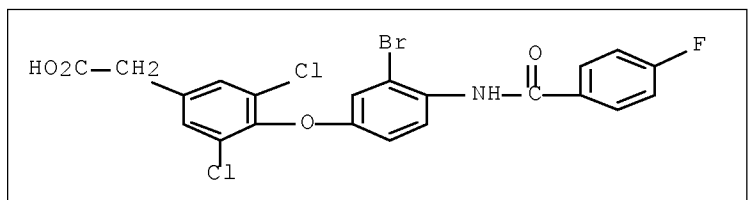
The claims are fully met when A is phenyl; R^1 and R^8 are hydrogen; D_b is CH_2 ; X is $NR^6C[O]_p$; D_a is a direct bond; R^6 is alkyl; R^2 are halogens; Y is bond; R^3 and R^4 are hydrogen; Q is $-C(O)OR^5$; and R^5 is methyl.

6. Claims 1 and 27 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kao Bio Ab [WO 01/98256, (Reference O, cited by the Examiner)].

The instantly claimed compounds are disclosed. At pages 4-6, see the compounds of formula I. The compounds are depicted below:

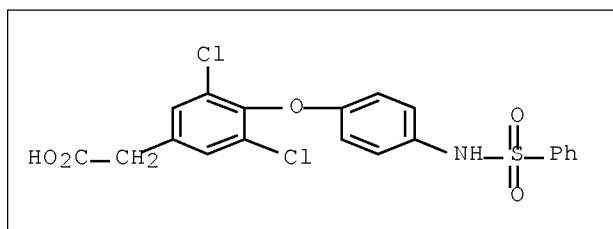


and

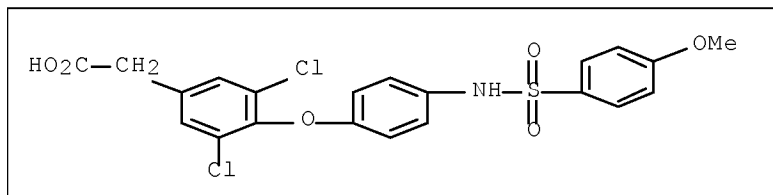


The claims are fully met when A is phenyl substituted by R^8 ; R^8 is halogen or hydrogen; D_a and D_b are direct bonds; X is $C[O]_pNR^6$; R^6 is hydrogen; R^1 is hydrogen or halogen; Y is bond; R^3 and R^4 are hydrogen; Q is $-C(O)OR^5$; and R^5 is hydrogen.

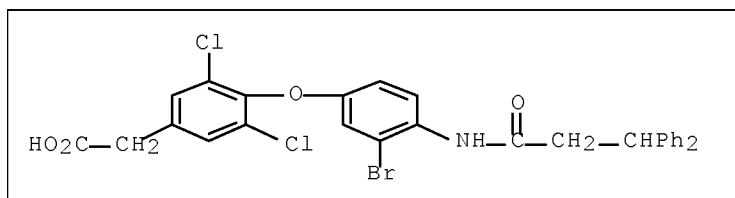
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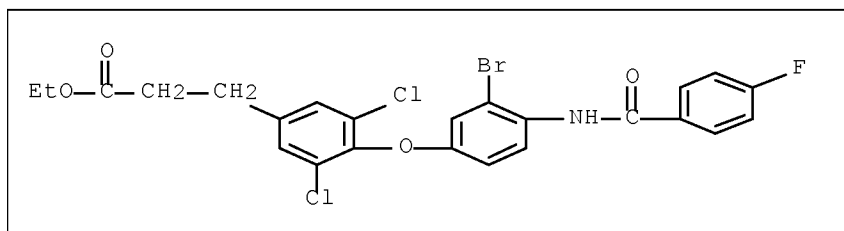
and



The claims are fully met when A is phenyl substituted by R^8 ; R^8 is alkoxy or hydrogen; D_a and D_b are direct bonds; X is $S[O]_2NR^6$; R^6 is hydrogen; Y is bond; R^3 and R^4 are hydrogen; Q is $-C(O)OR^5$; and R^5 is hydrogen.



The claims are fully met when A is phenyl; D_a is a direct bond; D_b is $-CR^cR^d$; R^c is hydrogen and R^d is aryl; X is $C[O]_pNR^6$; R^6 is hydrogen; R^1 and R^2 are halogens; Y is bond; R^3 and R^4 are hydrogen; Q is $-C(O)OR^5$; and R^5 is hydrogen.



The claims are fully met when A is phenyl substituted by R^8 ; R^1 , R^2 and R^8 are halogens; D_a and D_b are direct bonds; X is $C[O]_pNR^6$; R^6 is hydrogen; Y is bond; R^3 and

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R⁴ are hydrogen; Q is -C(O)OR⁵; and R⁵ is ethyl.

7. Claims 5-7, 9, 11, 12, 16, 20-22, 24-26, and 39 are objected to.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zinna Northington Davis whose telephone number is 571-272-0682.

11. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communications.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Zinna Northington Davis/
Zinna Northington Davis
Primary Examiner
Art Unit 1625

Znd
11.16.2009